



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>FS-F03215-01</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		Application Number <b>10/730,143</b>	Filed <b>December 9, 2003</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.   This request is being filed with a notice of appeal.   The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		First Named Inventor <b>Kouta Fukui</b>	
		<table style="width: 100%;"> <tr> <td style="width: 50%;">Art Unit <b>1752</b></td> <td style="width: 50%;">Examiner <b>Thorl Chea</b></td> </tr> </table>	
Art Unit <b>1752</b>	Examiner <b>Thorl Chea</b>		
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,474</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
<div style="display: flex; align-items: center;"> <div>             Signature  <b>Margaret A. Burke</b>              Typed or printed name  <b>(703)838-8013</b>              Telephone number  <b>January 26, 2006</b>              Date           </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.: 10/730,143 Confirmation No. 5961  
Applicant: Kouta Fukui  
Filed: December 9, 2003  
Title: PHOTOTHERMOGRAPHIC MATERIAL  
Art Unit: 1752  
Examiner: Thorl Chea  
Docket No.: FS-F03215-01  
Cust. No.: 37398

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicant submits the following arguments in support of the Pre-appeal Brief Request for Review. Applicant submits that there is at least one legal deficiency in the rejections. The legal deficiency lies in the Examiner's failure to present a prima facie case of obviousness by failing to provide a reference to teach or suggest at least two elements of Applicant's invention.

A complete set of the pending claims can be found in the response to the Office action of March 23, 2005.

Claims 1, 3-5, and 8-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent No. 5,998,126 to Toya et al., U.S. Patent No. 4,332,889 to Siga et al., U.S. Patent No. 5,958,668 to Matsumoto et al., U.S. Patent No 4,211,839 to Suzuki et al., and EP 1096310.

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Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent No. 5,998,126 to Toya et al., U.S. Patent No. 4,332,889 to Siga et al., U.S. Patent No. 5,958,668 to Matsumoto et al., U.S. Patent No. 4,211,839 to Suzuki et al., and EP 1096310 as applied to claims 1, 3-5, and 8-10 above and further in view of U.S. Patent No. 5,656,419 to Toya et al.

Claims 11-19 were rejected under 35 U.S.C. 103(a) over the combination of U.S. Patent No. 5,998,126 to Toya et al., U.S. Patent No. 4,332,889 to Siga et al., U.S. Patent No. 5,958,668 to Matsumoto et al., U.S. Patent No. 5,656,419 to Toya et al., and U.S. Patent No. 4,211,839 to Suzuki et al.

It is respectfully submitted that none of the above combinations of references renders any of the pending claims obvious. The invention of the present application is a photothermographic material which uses specific orthobisphenol reducing agents represented by formulas (R-1) and (R-2) together or (R-1) and (R-3) together. By using the specific orthobisphenol reducing agents of this invention together, a photothermographic material is obtained which exhibits an excellent silver image with both high sensitivity and pure black tone; such a material is not obtained using only the reducing agent represented by formula (R-1).

The effects of the use of specific orthobisphenol reducing agents together in this invention are shown in the photographic performance data in Table 1 of the specification. In Table 1, Experiments Nos. 5 and 6, each of which uses two kinds of specific orthobisphenol reducing agents together exhibit unexpectedly better color tone (pure black tone) while maintaining high sensitivity, compared to Experiment No. 4 which uses

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only one kind of reducing agent. Experiment Nos. 8 and 9, each of which uses two kinds of specific orthobisphenol reducing agents together, exhibit unexpectedly better sensitivity while maintaining pure black tone compared to Experiment No. 7 which uses only one kind of reducing agent.

Concerning the reference to Suzuki, the use of two reducing agents together is disclosed: 2,4-dialkyl substituted orthobisphenols and 2,6-dialkyl substituted parabisphenols. This does not teach or suggest the use of the combined orthobisphenols of the present invention.

Further, there is no teaching or suggestion to combine the references to obtain the combination of a silver iodide-based photothermographic material with the specific combination of orthobisphenols of the present invention. Instead, it is respectfully submitted that the Examiner has used impermissible hindsight to "pick and choose" individual components of the claimed invention from a wide variety of references in order to "recreate" the claimed invention. Thus it is submitted that a prima facie case of obviousness has not been made.


Concerning claims 11-19, there is no teaching or suggestion to combine a high silver iodide-based photothermographic material with the specific reducing agent of formula R-5 and the antifoggant of formula H in the claimed ratio. Thus it is submitted that a prima facie case of obviousness has not been made.

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In view of the foregoing remarks, it is respectfully submitted that a prima facie case of obviousness has not been made and all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,

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